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IV. REMARKS

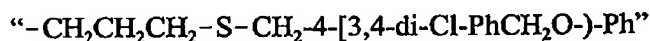
Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

1. Status of the Claims

Claims 27-40 are currently pending for examination on the merits.

2. Summary of the Amendments

Claim 28 has been amended to correct two obvious and inadvertent typographical errors. Specifically, the beginning bracket in the term:



has been changed to a parenthesis.

Additionally, an inadvertently omitted methylene unit has been inserted into "-CH₂-4-(4-Cl-Ph-O)-Ph" to recite in place thereof "-CH₂-4-(4-Cl-PhCH₂-O)-Ph." Support for this amendment is found, for example, on page 10, line 09.

Entry of these amendments is respectfully requested.

3. Objection to the Specification

The Examiner has indicated that the status of the parent application should be added to the claim for priority on page 1. In response, Application have amended the specification to indicate that the parent application has now issued as U.S. Patent No. 6,620,781 B2. Accordingly, this objection may be withdrawn.

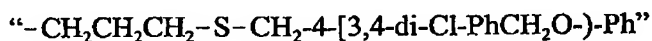
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4. Rejection Under 35 U.S.C. §112, First Paragraph

Claim 28 has been rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, the Examiner has indicated that the term “-CH₂-4-(4-Cl-Ph-O)-Ph” has no support in the original disclosure. In response, Applicants have amended Claim 28 to recite “-CH₂-4-(4-Cl-PhCH₂-O)-Ph” in place of “-CH₂-4-(4-Cl-Ph-O)-Ph” to correct this typographical error. Accordingly, this rejection may be withdrawn.

5. Objections to the Claims

Claim 28 has been objected to because the beginning bracket in the term:



does not match the end parenthesis. In response, Applicants have amended Claim 28 to insert a parenthesis in place of the bracket. Accordingly, this objection may be withdrawn.

Claims 29-32 and 34-36 have also been objected to as being dependent upon a rejected base claim. In view of the present amendments and remarks, Applicants believe the claims from which Claims 29-32 and 34-36 depend are now allowable and therefore, this objection may be withdrawn.

6. Obviousness-Type Double Patenting

Claims 27, 33, 37, 38 and 40 have been rejected under the judicially-created doctrine of obviousness-type double patenting in view of Claims 1-26 of U.S. Patent No. 6,620,781 B2. Additionally, Claim 39 has been rejected under the judicially-created doctrine of obviousness-type double patenting over Claims 1-26 of U.S. Patent No. 6,620,781 B2 in view of U.S. Patent No. 4,983,586 (to Bodor). In response, Applicants are submitting herewith a terminal disclaimer in compliance with 37 C.F.R. §1.321(c). Accordingly, these rejections may be withdrawn.

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Applicants note that the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Specifically, the courts have indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."


V. CONCLUSION

Reconsideration of this application in view of the above amendments and remarks is respectfully requested. Should there be any issues regarding this application that can be resolved by telephone, the Examiner is respectfully requested to telephone the undersigned attorney at (650) 808-6406.

Respectfully submitted,

THERAVANCE, INC.

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